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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,093	04/12/2001	Paul M. Crivelli	10006533-1	2770

7590

11/27/2002

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EXAMINER

HUFFMAN, JULIAN D

ART UNIT

PAPER NUMBER

2853

DATE MAILED: 11/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/834,093

Applicant(s)

CRIVELLI ET AL.

Examiner

Julian D. Huffman

Art Unit

2853

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 November 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-20.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

Continuation of 2. NOTE: The proposed amendment changes the scope of claims 16, 18 and 20 and would require further consideration and/or search.

Continuation of 10. Other: Applicant argues that Ishinaga et al. do not teach the limitation of "controlling temperature variations of the printhead to be within a predefined range from a starting point of a print swath to an end point of the print swath and successive print swaths of pigmented ink... and... minimizing air bubble growth rates and bubble sizes within the printhead to enable expulsion of the air bubbles from the printhead without clogging". Ishinaga was not cited to teach printing with pigmented ink and the examiner agrees that Ishinaga et al. do not disclose printing using pigmented ink, however the rejection is based on a combination of references and Kawanabe et al. disclose this feature. Column 25, lines 45-47 of Ishinaga et al. state that the recording operation is performed while controlling the temperature of the substrate. Thus Ishinaga et al. disclose controlling temperature variations from the starting point of a print swath to an end point of the print swath. In response to applicant's argument that Ishinaga et al. does not disclose minimizing air bubble growth rates and bubble sizes within the printhead to enable expulsion of the air bubbles from the printhead without clogging, this argument is not found persuasive since a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Additionally, Ishinaga et al. disclose comparing head temperature to a reference temperature and heating the heaters to increase the head temperature, or reducing the heater signal to reduce the head temperature accordingly. Further, applicant discloses in the background of the invention that temperature effects bubble growth rates and the formation of air bubbles and since Ishinaga et al. controls temperature of the head, Ishinaga et al. inherently controls bubble growth rates and formation of air bubbles. Further, in the method claims, the prior art performs the same steps as applicant and the result of performing the steps is necessarily a minimization of air bubble growth rates and bubble sizes which enable expulsion of the air bubbles from the printhead without clogging.


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